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REMARKS

Claims 1-45 are currently pending in the subject application and are presently under consideration. All pending claims can be found at pages 3-10. Claims 1, 6, 15-17, 26, 31, and 32 have been amended.

Favorable reconsideration of the subject patent application is respectfully requested in view of the comments and amendments herein.

I. Specification

The Examiner has reminded applicant of the proper language and format of an abstract of a disclosure by emphasizing that it is limited to a single paragraph of 150 words or less.

Applicant's representative respectfully points out, and recites at page 2 of this reply, the amended abstract that has been previously submitted before the USPTO on two separate occasions, namely in a Reply to Notice to File Corrected Application Papers of Non-Provisional Application dated May 10, 2001 (mailed 6/22/01) and a Reply to Notice to File Corrected Application Papers Dated August 2, 2001 (faxed 4/7/03).

II. Rejection of Claims 6, 26-28, and 40 Under 35 U.S.C. §112, second paragraph

Claims 6, 26-28 and 40 stand rejected under 35 U.S.C. §112, second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 6 and 26 have been amended to more particularly point out and distinctly claim the invention. Claims 27 and 28 depend from claim 26 and are also now in condition for allowance.

It is unclear what the Examiner's intentions were with regard to claim 40. No explanation of why claim 40 was rejected under 35 U.S.C. §112 was given in the Office Action. This claim does not contain "the various user type classes" language that the Examiner objected to for claims 6 and 26. Applicant respectfully submits that claim 40 is acceptable, without amendment, under 35 U.S.C. §112, second paragraph.

For the above reasons, this rejection should be withdrawn for claims 6, 26-28, and 40.

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III. Rejection of Claims 1-21 and 44-45 Under 35 U.S.C. §103(a)

Claims 1-21 and 44-45 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Yinger *et al.* (US 5,960,204 - hereinafter referred to as "Yinger") in view of Cherkasova *et al.* (US 6,425,057 - hereinafter referred to as "Cherkasova"). Claims 1 and 15-17 have been amended herein to more clearly emphasize the invention.

Withdrawal of this rejection is respectfully requested for at least the following reasons. The Examiner has not established a *prima facie* case of obviousness. No motivation to modify the references exists, no reasonable expectation of success exists, and the references (alone or in combination) fail to teach or suggest all limitations of the subject claims.

To reject claims in an application under §103, an examiner must establish a *prima facie* case of obviousness. This is accomplished by a showing of three basic criteria. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. See MPEP §706.02(j). The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. See *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Additionally, the Federal Circuit has consistently held that:

... 'virtually all [inventions] are combinations of old elements.' Therefore an examiner may often find every element of a claimed invention in the prior art. If identification of each claimed element in the prior art were sufficient to negate patentability, very few patents would ever issue. Furthermore, *rejecting patents solely by finding prior art corollaries for the claimed elements would permit an examiner to use the claimed invention itself as a blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention. Such an approach would be 'an illogical and inappropriate process by which to determine patentability.'* *In re Rouffer*, 149 F.3d 1350, 1357, 47 U.S.P.Q.2d 1453 (Fed. Cir. 1998) (citations omitted).

Yinger employs a reactive determination scheme that responds to application selections by a user. In essence, it determines if a requested application exists or not and makes the application available to the user if it is not available. Yinger states, "In response to a client computer receiving a request from a user to run an application, the client computer determines whether the application exists on the client computer" (emphasis added, col. 1,

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lines 59-61) and "... if the desired application is available on a server computer, the server computer automatically installs the application on the client computer ..." (emphasis added, col. 1, lines 63 - 66). Other embodiments of Yinger only check to see if installed software is a current version or not before updating the installed software (see, col. 2, lines 5-9).

Yinger further states, "The system and the method in accordance with the present invention minimizes use of valuable system resources, such as storage device space on the client computer, because not all new or updated application modules are necessarily installed on each client computer" (emphasis added, col. 2, lines 10-14). Yinger accomplishes this "minimization" by first determining if a user requests the application and then if the application is up-to-date. This is wholly contrary to the claimed invention "proactively maximizing an expected value of downloaded resources" (emphasis added, per amended claims 1, 15, 16, and 17). Yinger makes no determination whatsoever of the expected value of what is downloaded to a client. Yinger assumes that resources are minimized as a side result of only downloading what a user requests. This passive method is directly counter to the claimed invention which actively determines maximized downloaded resources. Thus, Yinger does not teach or disclose this limitation of the claimed invention. Since Yinger does not disclose this limitation, combining Yinger with Cherkasova does not obviate the claimed invention. And, therefore, applicant respectfully requests that this rejection be withdrawn for the *supra* reasons and that claim 1 (and its dependent claims 2-14, 44, and 45), claim 15, claim 16, and claim 17 (and its dependent claims 18-21) be allowed to issue.

IV. Rejection of Claims 22-39 and 41-43 Under 35 U.S.C. §103(a)

Claims 22-39 and 41-43 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Yinger *et al.* in view of Cherkasova *et al.* and in further view of Fischer *et al.* (US 6,438,672). Claims 22, 31, and 32 have been amended herein to more clearly emphasize the invention.

Claims 22-31, 39, and 41-43

Cherkasova is a cache eviction process that determines a cache storage utility value based on cost of obtaining an object and size of an object. "The method and the system may be used to establish a replacement strategy for caching objects in local cache

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of a proxy connected to the Internet" (emphasis added, col. 4, lines 61-63). "For each object, a utility value of retaining the object in cache is computed. Objects with the smallest utility value are replaced. The utility value is designed to capture the utility of retaining a given object in the cache" (emphasis added, col. 3, lines 14-18). *Contrary* to the claimed invention, Cherkasova is based on parameters that are relevant to evicting existing objects *rather than* "minimizing total expected latencies to request and receive resources via utilization of the user-based factor, the resource-based factor, and the storage facility-based factor" as in the claimed invention (emphasis added, claim 22). Cherkasova employs such parameters as length of stay in the cache and number of 'hits' to determine if the object should be removed. This information is determined *after* the object has been downloaded into the cache. Thus, it teaches assessment of parameters that are only relevant after the fact (download) which is inapposite to the claimed invention which determines value *before* downloading. Thus, Cherkasova does *not* disclose or teach this limitation of the claimed invention.

Additionally, the Examiner cites Yinger as teaching "*accepting a user-based factor*" (claim 22) with reference to column 1, lines 59-67 which discloses a system that determines if an application is available, and, if not, downloads that application. The only 'user function' recited in this section of Yinger is "a request from a user" (col. 1, lines 59-60) which is not a "*user-based factor*" as in the claimed invention ("such as *user type classes, usage type classes and probabilities that a particular user belongs to the various user type classes, for example*"- abstract of present invention). Thus, Yinger does *not* disclose or teach this limitation of the claimed invention.

Moreover, the separate deficiencies of Yinger and Cherkasova also prevent the combination of Yinger and Cherkasova from obviating the claimed invention. Additionally, the further combination of Fischer with Yinger and Cherkasova also does not overcome the separate and combined deficiencies of Yinger and Cherkasova. Thus, applicant respectfully requests that this rejection be withdrawn and that claim 22 (and its dependent claims 23-31) be allowed to issue. The Examiner has also cited that claims 39 and 41 are rejected in the same manner as claim 22, and, thus, applicant additionally requests that this rejection also be withdrawn and that claims 39 and 41 (and its dependent claims 42-43) be allowed to issue as well.

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Claims 32-38

Applicant respectfully traverses the Examiner's statement that "The limitations of claims 32-38 correspond to the limitations of claims 22-31 and as such are rejected in a similar manner." Claims 22-31 include "*minimizing total expected latencies to request and receive resources*." Claim 32 (and its dependent claims 33-38 does not include this limitation. Claim 32 (as amended) includes proactively maximizing a value. Thus, as stated *supra* for claim 1, this proactive limitation of the claimed invention is not taught or disclosed in Yinger. Thus, for the reasons stated for claim 1, this rejection should be withdrawn.

V. Rejection of Claim 40

The Examiner did not include claim 40 in either 35 U.S.C. §103(a) rejection above. Page 11 of the Office Action however, includes claim 40 under the grouping of claims 1-21 and 44-45. Applicant therefore assumes that claim 40 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Yinger *et al.* (US 5,960,204 - hereinafter referred to as "Yinger") in view of Cherkasova *et al.* (US 6,425,057 - hereinafter referred to as "Cherkasova").

Even though the Examiner did not cite the necessity of combining Yinger and Cherkasova with Fischer, the rejection for claim 40 should be withdrawn for the reasons cited *supra* in section IV based on the separate and combined deficiencies of Yinger and Cherkasova.

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CONCLUSION

The present application is believed to be in condition for allowance in view of the above comments and amendments. A prompt action to such end is earnestly solicited.

In the event any fees are due in connection with this document, the Commissioner is authorized to charge those fees to Deposit Account No. 50-1063[MSFTP291US].

Should the Examiner believe a telephone interview would be helpful to expedite favorable prosecution, the Examiner is invited to contact applicant's undersigned representative at the telephone number listed below.

Respectfully submitted,
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